



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Neil W. Boaz

Serial No. 10/004,413

Filed: December 6, 2001

For: PREPARATION OF SUBSTITUTED  
AROMATIC CARBOXYLIC ACID  
ESTERS

Group Art Unit: 1625

Examiner: Oh, Taylor V.

Confirmation No. 8373

United States Patent and Trademark Office  
Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION  
OF PATENT TERM ADJUSTMENT**

Sir:

Applicant hereby respectfully requests the Commissioner to reconsider the patent term adjustment for the above-identified patent. Specifically, Applicant respectfully requests that the term of the above patent be adjusted by 905 days, instead of 109 days as shown on the currently issued patent. This entire delay was due to a U.S. Patent and Trademark Office (USPTO) error and not that of the Applicant.

Applicants are entitled to an additional 796 day patent term adjustment under 35 U.S.C. § 134 because the USPTO failed to respond to Applicant within four months of Applicant's Response to Office Action filed August 18, 2003. The USPTO is required under 37 C.F.R. § 1.702(a)(2) to respond to an Applicant's reply no later than four months from the date the reply was filed or an appeal was taken. The USPTO failed to meet this deadline.

The USPTO caused the entire delay by mailing the February 25, 2004, Notice of Allowance and Issue Fee Transmittal to the wrong address. Upon examination of the February 25, 2004, Notice of Allowance, it appears that the USPTO mailed the Notice of Allowance using the wrong customer number. That is, instead of mailing

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the correspondence to customer number 22204, the USPTO mailed the correspondence to customer number 22201. This error caused the entire delay. A corrected Notice of Allowance and Issue Fee Transmittal was mailed on February 21, 2006. Accordingly, Applicants are seeking an additional 796 days, which is from December 18, 2003 (August 18, 2003 + four months) to February 21, 2006.

The following is a timeline of the relevant facts.

- December 6, 2001 - The Application was filed as a continuation application under 37 C.F.R. § 1.53(b), of pending prior application no. 09/288,642.
- August 18, 2003 - A Revocation of Power of Attorney, Appointment of New Power of Attorney or Authorization Agent, Change of Correspondence Address was filed, and Response to Office Action under 37 C.F.R. § 1.111.
- February 25, 2004 - Notice of Allowance and Issue Fee was mailed to the incorrect address as an incorrect customer number was used.
- February 22, 2006 - Corrected Notice of Allowance And Fee(s) mailed.

On or about February 6, 2006, Examiner Taylor Victor Oh contacted Applicants representatives to request our address. The Examiner informed us that over the last two years the Examiner had repeatedly sent out the Notice of Allowance and Issue Fee Transmittal, however, the documents were being returned as having been sent to a bad address. The Examiner repeatedly informed the mail room of the correct address, however, the documents were still being mailed to the incorrect address. Unfortunately, Applicant's representatives were not notified of the issue until February 6, 2006.

Specifically, on February 6, 2006, the Examiner sent a facsimile to Applicant's Representative's office including a Notice of Allowance, Issue Fee Transmittal, and Examiner's Amendment having a mailing date of February 25, 2004. After numerous phone calls with Examiner Taylor Victor Oh, Cecilia Tsang (SPE), and Debra Dottsom (HLIE) we discovered the customer number that the USPTO entered was the wrong customer number. Thus the delay in notifying Applicant of the Notice of Allowance was a USPTO error.


For at least the foregoing reasons, Applicant respectfully requests the Commissioner to add 796 days to the current patent term adjustment. Therefore, the patent term adjustment for this patent should be 905 days. Applicants further submit that this patent is not subject to any terminal disclaimer, and Applicants are not aware of any other circumstances that would constitute any failures to engage in reasonable efforts to conclude processing or examination.

The Commissioner is hereby authorized to charge the required fee for this petition to Deposit Account No. 19-2380. Should the Commissioner have any questions, the Commissioner is invited to contact Applicants' representative designated below.

Respectfully submitted,

**NIXON PEABODY LLP**

Dated: May 19, 2006

  
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